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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,410	06/23/2003	Joseph P. Desmond	10124/10001	7691
30636 7590 08/25/2011 FAY KAPLUN & MARCIN, LLP 150 BROADWAY, SUITE 702 NEW YORK, NY 10038				
EXAMINER				
SZPIRA, JULIE ANN				
ART UNIT		PAPER NUMBER		
3731				
MAIL DATE		DELIVERY MODE		
08/25/2011		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/601,410

**Applicant(s)**

DESMOND, JOSEPH P.

**Examiner**

JULIE A. SZPIRA

**Art Unit**

3731

***—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —***

THE REPLY FILED 01 August 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-10, 17-23, 27-29, 32-34 and 37-48  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

/S. Thomas Hughes/  
Supervisory Patent Examiner, Art Unit 3731

/J. A. S./  
Examiner, Art Unit 3731  
August 23, 2011

Continuation of 11, does NOT place the application in condition for allowance because: Applicant's arguments have been fully considered but they are not persuasive.

Regarding the wedge disclosed by Page, the arguments regarding the use of the wedge are not persuasive. The wedge disclosed by Page function as the wedge disclosed in the claims as the present invention, as the wedge, when in a desired position will prevent relative movement between two co-axially disposed hollow members. The wedge creates a friction fit between an inner and outer member and does not allow the members to move when the wedge is in a locking position. The wedge disclosed by Page can be moved to a secondary position, as the wedge is an independent structural feature, and is not fixed to or integral with either hollow member.

In response to applicant's argument that the wedge in Page is used to attach devices to one another, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Furthermore, the present invention calls for two hollow member to be attached to one another to form a device with a length that is longer than either individual tube. The invention disclosed by Page teaches and is capable of achieving that structural configuration.

The claim language does not specifically disclose that the wedge is placed in a specific configuration, rather, the claims call for the wedge to be capable of achieving that configuration. The broad claim language, such as the terms "disposable" and "slidable" require that the wedge can achieve the configuration as disclosed. Due to the claims calling for the device to be capable of the claimed configurations, the prior art disclosed the invention. The wedge disclosed in Page and Peterson meet the limitations of being disposable and slidable, and thus meets the structural limitations.

In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references of Peterson, Best Jr, and Stouder, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, the idea of telescoping hollow tubular elements is taught by each of the above references, and would be known to one having ordinary skill in the art at the time the invention was made. Peterson discloses a first hollow member extending distally beyond a second hollow member and Stouder teaches the opposite. The ultimate goal of either device is to have a compact device that can be longitudinally extended and inserted into the body cavity. The modification of Peterson to disposed the second hollow member distally beyond the first hollow member is an obvious variation of positions of hollow members. The change in length of a member would have been obvious to one having ordinary skill in the art in order to accommodate varying surgical procedures, as well as to accommodate the differences in the sizes of patients, such as the difference between a child and an adult.